

VERSION WITH MARKINGS TO SHOW CHANGES MADE

1. (Amended) A business method relating to beverage containers comprising:

conveying by ~~revenue producing profit making~~ sale a right to attach indicia to consumer removed, highly flexible and collectable protective members to be adhered to beverage containers;

manufacturing the protective members;

applying indicia to the protective members; and

adhering the protective members to the containers.

3. (Amended) The method of claim 1 in which the protective members are made in an hourglass configuration to facilitate adherence to a top and convex side of a container without deformation and without wrinkling of a material of the protective member by folding it over a rim of a beverage can when adherence occurs.

16. (Amended) A business method relating to beverage containers comprising:

conveying by ~~revenue producing profit making~~ sale a right to attach indicia to consumer removed, highly flexible and collectable protective members to be adhered to beverage containers;

manufacturing the each protective members in a hourglass configuration to facilitate adherence to a top and convex side of a container without deformation and without wrinkling of a material of the each protective member;

applying indicia to the each protective members; and

adhering ~~the each~~ protective members to ~~the a~~ containers
including by folding each over a rim of a beverage can.

17. (Amended) A business method relating to beverage containers comprising:

conveying by ~~revenue producing profit making~~ sale a right to attach indicia to consumer removed, highly flexible and collectable protective members to be adhered to beverage containers;

manufacturing the protective members;

applying indicia to opaque protective members by printing on the underside thereof to facilitate using the method for such things as games of chance, premiums, collectables, redeemables, merchandise acquisition means, and prizes without a user knowing in advance of the protective member removable which of a plurality of chances the user has obtained; and

adhering the protective members to the containers.

REMARKS

This Amendment responds to an Office Action mailed on December 23, 2002. It was a first Office Action following a Request for Continued Examination (RCE). The Office Action rejected all 17 pending claims. Claims 1, 3, 16 and 17 have been amended herewith. Reexamination, reconsideration and allowance of all 17 pending claims are respectfully requested. A clean copy of all currently pending claims as presently amended is attached hereto.

In response to the Amendment filed on November 7, 2002, the Examiner again withdrew the basis of her rejections, this time based on the addition of limitations that the protective members were "consumer removed, flexible, and collectable." In the Remarks section of the Preliminary Amendment filed on November 7, 2002, Applicant complained that the Examiner was citing references for more than what they actually teach. It is respectfully suggested she is continuing to do that with the current Office Action responded to herewith.

For example, in the present Office Action, claims 1-2, 4-5, 12 and 14-15 have been rejected as obvious using a total of four references. Those references are Ruemer, U.S. Patent No. 4,402,421, Granofsky, U.S. Patent No. 5,108,003, Blotky, U.S. Patent No. 6,084,526 and Bozlee, U.S. Patent No. 6,354,645. The Examiner claims in citing Ruemer that it is directed to a protective member for a beverage container, and that it teaches manufacturing a consumer removed flexible and collectable protective member and attaching promotional indicia (Fig. 6) to the protective member. (Emphasis added). Respectfully, Ruemer does not

teach that the protective member is flexible as best shown on figures 4 and 7. To further emphasize the distinction with Ruemer, Applicant has amended claim 1 to recite that the protective member is "highly" flexible. The predicates for this amendment lie at page 9, lines 25 and 26, through page 10, line 2, and page 10, lines 15 through 18, of the specification.

Perhaps more significant amendment to claim 1 is been to emphasize that this a business method patent application that has not drawn a single business method reference. The Examiner has located references where revenue producing advertising is taught, such as Blotky, U.S. Patent No. 6,084,526 and Bozlee, U.S. Patent No. 6,354,645. But these are not business method patents. Blotky is actually an electronic apparatus patent while Bozlee is an apparatus patent that includes a method for advertising. Neither these two references nor any other reference of record teaches the profit making motive that accompanies a business method, let alone also concerning protective members on beverage cans.

Accordingly, Applicant has deleted, without prejudice, the phrase "revenue producing" from claims 1, 16 and 17 and has substituted the more pointed phrase "profit making." All references cited by the Examiner teach advertising as not monetarily related, cost offsetting (without profit), or for product promotion. The teachings of the present invention are profit motivated because this is a business method patent application. The predicate for the addition of the phrase "profit making" is found at page 7 line 26 of the specification.

Before leaving these references, it is respectfully submitted

that Bozlee is nonanalogous art. Bozlee has nothing to do with the beverage container industry, or advertising in the beverage can industry, and it does not teach the us of that industry to make money in a new business method. Alternatively, there is nothing in either Bozlee or any of the other references cited to suggest the combination of Bozlee with the other references. Briefly put, there is no suggestion to combine these references. It is also noted with some interest that the Examiner has used the combination of *SIX* references to reject claim 8 as obvious. That would appear to severely strain the meaning of the word "obvious" in the nearly twenty-seven year patent prosecuting experience of undersigned counsel.

Turning now to claim 3, the Examiner has cited Cummings, U.S. Patent No. 4,514,248 as a basis for rejecting claim 3 and claim 16. Once again, it is suggested that the Examiner is stretching the reference beyond the four corners of the document. Cummings teaches a substantially modified hourglass shape having substantially unequal sides in which one side is a sealing cover and the other is a pull tab. Figures 4 and 5 and the accompanying description make it clear that pull tab 16 and especially the narrowed down unnumbered portion thereof between cover 14 and pull tab 16 has nothing to do with facilitating adherence without wrinkling or defamation of a protective member as placed over the top of a circular structure and the convex side thereof. No assertion is made by Cummings that the "neck" or narrowed down portion serves any particular purpose other than as a connection between pull tab 16 and cover 14. Cummings merely states, column

3 lines 64 through column 4 line 2 as follows:

a pull-tab may be joined to the generally circular shaped container closure for removing the closure from the specially coated carrier liner, aligning it with its center over the "target area" of the container top, and to facilitate removing the closure from the container to leave a telltale strip on the metal rim as verification that the seal was applied in Pharmacy.

The mere fact that the Examiner located a modified hourglass shape in the art does not mean that the reference teaches the specific purposes for which that shape is used in the present invention. However, to further distinguish the Cummings reference, applicant has added to claims 3 and 16 that the hourglass configuration facilitates adherence to a top and convex side of a container without deformation and without wrinkling of the material of the protective member by folding it [each] over a rim of a beverage can." The predicate for these amendments is contained in the specification at page 16, line 2.

It is believed that the changes to claims 1, 3, 16 and 17 should render all claims allowable over the references of record because amended claim 1 recites the profit making motive of a business method patent application that is completely absent from all presently cited references, and all claims other than the independent claims 16 and 17 having similar limitation to claim 1 depend from claim 1. Accordingly, allowance is respectfully requested.

Although Applicant believes that all the presently pending claims are now in condition for allowance, undersigned counsel remains available for a telephone interview if doing so will

facilitate the resolution of any remaining technicalities, such as may be the proper subject of an Examiner's Amendment with the concurs of undersigned counsel. In the event such an interview would be of use, the Examiner is respectfully invited to telephone undersigned counsel at the telephone number listed below.

One final note concerns the response timing of this Amendment. The shortened statutory period for reply to the Office Action arguably expired yesterday, March 23, 2003. However, March 23, 2003 was a Sunday, so this response is timely on March 24, 2003. Respectfully submitted,

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